

REMARKS

In the Office Action mailed November 24, 2009 (hereinafter, "Office Action"), the Examiner rejected claims 1-5, 7, 8, 13, 14, 32-36, 38, 39, 44, 45, 63-67, 69, 70, 75, 76, 94, 96, and 98 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,569,897 to Masuda (hereinafter, "Masuda") in view of a document entitled, "Contracts Law in Action," by Stuart Macaulay et al. (hereinafter, "Macaulay"); rejected claims 6, 9, 10, 37, 40, 41, 68, 71, and 72 under § 103(a) as being unpatentable over Masuda in view of Macaulay and case law; and rejected claims 15-20, 46-51, 73, 74, and 77-82¹ under § 103(a) as being unpatentable over Masuda, Macaulay, and an article entitled "Automatic bill payment offers convenience, punctuality," authored by Bradley Foss (hereinafter, "Foss"), an article entitled "Phone Companies' Plans Challenge Wireless Providers," authored by Michael Sasso (hereinafter, "Sasso"), and an article entitled "Temporary Suspension of Service Due to Overdue Bill for the CBD Printing Fee," published by Commerce Business Daily (hereinafter, "Commerce"); and rejected claims 95, 97, and 99² under § 103(a) as being unpatentable over Masuda, Macaulay, and an article entitled "Card issuers' freebies offer expected to last till year-end," authored by Kang Siew Li (hereinafter, "Li").

¹ In the Office Action, the Examiner indicates that claims 42, 43, 95, 97, and 99 are rejected under § 103(a) as being unpatentable over Masuda, Macaulay, Foss, Sasso, and Commerce. Office Action, p. 7. However, Applicants note that claims 42 and 43 were previously canceled, and claims 95, 97, and 99 are not addressed in the detailed rejection using this combination of prior art. Instead, claims 95, 97, and 99 appear to be rejected under § 103(a) as being unpatentable over the combination of Masuda, Macaulay, and Li. See Id. at pp. 8-9. Accordingly, Applicants believe that the rejection statement on page 7 of the Office Action includes typographical errors, and respond herein accordingly.

² While the Examiner did not identify claims 97 and 99 in the rejection statement on page 8 of the Office Action and did not provide a detailed rejection of claims 95, 97, and 99 over the combination of Masuda, Macaulay, Foss, Sasso, and Commerce, the Examiner provided a detailed rejection of these claims under § 103(a) over Masuda, Macaulay, and Li. Id. at p. 9. Accordingly, Applicants believe that claims 95, 97, and 99 stand rejected over Masuda, Macaulay, and Li, and respond herein accordingly..

Claims 11, 12, 42, 43, 73, and 74 were previously canceled, and claims 21-31, 52-62, and 83-93 were withdrawn. Accordingly, claims 1-10, 13-20, 32-41, 44-51, 63-72, 75-82, and 94-99 are currently under examination.

Based on the reasoning presented below, Applicants respectfully traverse the rejections of claims 1-10, 13-20, 32-41, 44-51, 63-72, 75-82, and 94-99 under 35 U.S.C. § 103(a), and request allowance of the pending claims.

I. Rejections under 35 U.S.C. § 103(a)

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2141, 8th Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” Id. at § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. Id. at § 2143.01(III). In addition, when “determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” Id. at § 2141.02(I) (internal citations omitted) (emphasis in original).

Here, the cited prior art fails to disclose or suggest, either alone or in any reasonable combination, *inter alia*, “causing the point-of-sale location to prevent the consumer’s purchase of the product if the application for the credit card account

received from the consumer through the point-of-sale location is not approved," as recited in independent claim 1, and similarly recited in independent claims 32 and 63.

The Examiner acknowledges that "Masuda does not explicitly teach that the denial of the application will not allow the purchase to be made . . ." Office Action, p. 3. To overcome this deficiency of Masuda, the Examiner cites Macaulay, stating that "Macaulay teaches having a contract with a way out such as confirming the customer's creditworthiness." Id. The Examiner attempts to support this combination by stating that "it would have been obvious . . . that the denial of a credit application for the card that was part of the contract could result in the cancellation of the contract including the denial of the goods that had been bargained for if the contract had been fulfilled." Id. at p. 4.

However, even assuming the Examiner's assertions regarding Macaulay are correct, a statement to which Applicants do not assent, the Examiner's statements and corresponding conclusions are not consistent with the claim recitations. That is, the Examiner has impermissibly conflated the claim 1 recitations of "receiving an application for the credit card account . . ." and "receiving a notification reflecting a consumer request to purchase a product . . .," and incorrectly interpreted the elements of contract law, as disclosed in the Macaulay reference.

Specifically, the Examiner's conclusion at page 4 of the Office Action that "denial of a credit application . . . could result in the cancellation of the contract" is premised upon the assumption that a contract has been formed. Applicants respectfully note that, while Macaulay discloses contracts in which the "performance [is] subject to a condition," Macaulay's disclosure on pages 814-815 is an example of "a condition that

goes to creating a contract," not the performance of an already-created contract. In either case, however, as Macaulay illustrates, a contract requires both an offer and an acceptance of that offer,³ and Applicants' claims do not recite the contractual requirements of an offer and acceptance of that offer.

That is, assuming *arguendo* that the claim 1 recitation of "receiving an application for the credit card account" is an offer,⁴ as discussed in Macaulay, that offer is **only related to a credit card account, not** "a purchase [of] a product at a point-of-sale location," as recited in claim 1. Thus, it follows that the Examiner's conclusion that the "denial of a credit application . . . could result in the cancellation of the contract" (i.e., acceptance), at best, would **only relate to the credit card account** (i.e., the offer), **not** "a purchase [of] a product at a point-of-sale location," as recited in claim 1.

Accordingly, Macaulay does not overcome the deficiencies of Masuda, including the failure of Masuda to disclose or suggest the claim 1 recitation of "causing the point-of-sale location to prevent the consumer's purchase of the product if the application for the credit card account received from the consumer through the point-of-sale location is not approved." Therefore, independent claim 1 is nonobvious over Masuda and Macaulay, and should be allowed.

Independent claims 32 and 63, although of different scope, include recitations similar to those discussed above in connection with claim 1. Therefore, for at least the

³ See Macaulay, pp. 814-15 ("all resulting customer offers (orders) are thus subject to acceptance at Seller's offices at the address shown on the face here, before any contract is formed" (emphasis added)).

⁴ Applicants do not concede, either directly or by implication, that the claim 1 recitation of "receiving an application for the credit card account from the consumer through a point-of-sale location" is a contract offer.

same reasons, independent claims 32 and 63 are also nonobvious over Masuda and Macaulay, and should be allowed.

Claims 2-5, 7, 8, 13, 14, and 94 depend from independent claim 1; claims 33-36, 38, 39, 44, 45, and 96 depend from independent claim 32; and claims 64-67, 69, 70, 75, 76, and 98 depend from independent claim 63. As discussed above, a *prima facie* case of obviousness has not been established because Masuda and Macaulay do not teach or suggest the recitations of independent claims 1, 32, and 63, including the recitation of "causing the point-of-sale location to prevent the consumer's purchase of the product if the application for the credit card account received from the consumer through the point-of-sale location is not approved," as recited in independent claims 1, 32, and 63.

With respect to claims 6, 9, 10, 37, 40, 41, 68, 71, and 72, which depend from independent claims 1, 32, and 63, the Examiner has rejected these claims § 103(a) as being unpatentable over Masuda in view of Macaulay and "case law." Office Action, p. 6. Notwithstanding whether the cited case law is applicable to claims 1, 32, and 63, from which claims 6, 9, 10, 37, 40, 41, 68, 71, and 72 depend, case law does not overcome the failure of Masuda and Macaulay to disclose or suggest, *inter alia*, "causing the point-of-sale location to prevent the consumer's purchase of the product if the application for the credit card account received from the consumer through the point-of-sale location is not approved," as recited in claims 1, 32, and 63.

With respect to claims 15-20, 46-51, 73, 74, and 77-82, which depend from independent claims 1, 32, or 63, the Examiner has rejected these claims under § 103(a) as being unpatentable over Masuda and Macaulay in view of Foss, Sasso, and Commerce. Office Action, p. 7. The Examiner relies upon Foss to "teach[] paying bills

by automatic payment using credit cards," relies upon Sass to teach "AT&T wireless service," and relies upon Commerce to teach "a listing of agencies that will not be allowed to use a printing service for failing to pay their bill." Id.

However, even assuming that Foss, Sasso, and Commerce include the teachings alleged by the Examiner, which Applicants do not concede, none of Foss, Sasso, and Commerce, whether taken alone or in any reasonable combination, overcome the deficiencies of Masuda and Macaulay, as discussed above, including the failure of Masuda and Macaulay to disclose or suggest, *inter alia*, "causing the point-of-sale location to prevent the consumer's purchase of the product if the application for the credit card account received from the consumer through the point-of-sale location is not approved," as recited in claim 1, and similarly recited in claims 32 and 63.

With respect to claims 95, 97, and 99, which depend from independent claims 1, 32, and 63, the Examiner has rejected these claims under § 103(a) as being unpatentable over Masuda and Macaulay in view of Li. Office Action, p. 8. The Examiner relies upon Li to "teach[] offering giveaways for signing up for credit cards." Id. Assuming, however, that Li includes the teaching alleged by the Examiner, which Applicants do not concede, Li does not overcome the deficiencies of Masuda and Macaulay, as discussed above, including the failure of Masuda and Macaulay to disclose or suggest, *inter alia*, "causing the point-of-sale location to prevent the consumer's purchase of the product if the application for the credit card account received from the consumer through the point-of-sale location is not approved," as recited in claim 1, and similarly recited in claims 32 and 63.

For at least these additional reasons, the cited art does not support the § 103(a) rejections of claims 2-10, 13-20, 33-41, 44-51, 64-72, 75-82, and 94-99, and the rejection of these claims is thus legally deficient. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 2-10, 13-20, 33-41, 44-51, 64-72, 75-82, and 94-99.

II. Conclusion

In view of the foregoing, Applicants submit that the pending claims are neither anticipated nor rendered obvious in view of the cited art. Applicants therefore request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

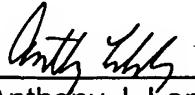
In addition, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 24, 2010

By: 
Anthony J. Lombardi
Reg. No. 53,232